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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Sutherland Asbill & Brennan
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EXAMINER

KUMAR, PREETI

ART UNIT PAPER NUMBER

1751

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,159

Applicant(s)

FRANCKE ET AL.

Examiner

Preeti Kumar

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on July 22, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Non-Final Rejection

Response to Amendment

1. Claims 1-5 are pending.
2. The rejection of claims 2 and 3 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn. Specifically the rejection is withdrawn for claim 2, in light of applicant's arguments that "the iodine number as claimed refers to an inherent property of the recited unsaturated fats, oils, waxes of natural or synthetic origin, and therefore, antecedent basis is inherent in the claim. Specifically, the rejection is withdrawn for claim 3 in light of applicant's amendment to the claims.
3. The rejection of claims 1 and 4 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn.
4. The rejection of claims 1,3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Covington (US 4,937,009) is withdrawn upon further consideration.
5. The rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Covington (US 4,937,009) is withdrawn upon further consideration.
6. The objection to claim 5 under 37 CFR 1.75(c) as being in improper form is maintained since the amendment does not comply with the accepted multiple dependent claim language requirement of referring to other claims in the alternative only. Please see MPEP § 608.01(n). Specifically part A. Acceptable Multiple Dependent Claim Wording.

7. The rejection of claims 1, 3-5 under 35 U.S.C. 102(b) as being anticipated by Hopkins et al. (US 4,560,386) is maintained for the reasons recited in the previous office action and further explained below.

8. The rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Hopkins et al. (US 4,560,386) is maintained for the reasons recited in the previous office action.

Response to Arguments

9. Applicant's arguments with respect to claims 1-5 have been considered but they are not persuasive. Specifically, Applicants urge that Hopkins et al. do not teach that the fatty acid derivative was subjected to an oxidative treatment prior to a further chemical reaction. In response, the MPEP states that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. Examiner has clearly described how the composition taught by Hopkins et al. is the same as the composition claimed by the pending claims. See the previous office action dated 3/19/2004. Since the product in the product-by-process claim is the same as the product of the prior art, the claim is unpatentable even though the prior art product may have been made by a different process. See MPEP 2113.

New Grounds of Rejection

Claim Objections

10. Claims 1 and 4 are objected to because of the following informalities:

Specifically regarding claims 1 and 4, the limitation to retanning agent is not supported by the specification. Examiner does not find support for retanning agents. Examiner finds support for *tanning* agents on page 4, last paragraph- page 5.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 provides for the use of the agent, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 5 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

13. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Friese et al. (US 4,903,362).

Friese et al. teach that sulfited fats are used as oiling agents for leather and skins and are produced by oxidation of fats with oxygen-containing gas mixtures, for example air, and simultaneous or subsequent sulfitation with alkali and/or ammonium hydrogen sulfite. For fats to be sulfited at all, it is absolutely essential to oxidize them before or during sulfitation by introduction of oxygen-containing gas mixtures. See col.1, ln.15-30. Friese et al. illustrates sulfitable fats having iodine numbers below 100, for example coconut oil, palm kernel oil, palm oil, tallow, lard, neat's-foot oil, sperm oil, whale oil, triolein, oleic acid, wax esters, fatty acid monoglycerides, fatty acid diglycerides, and/or fatty acid triglycerides, form readily water-emulsifiable sulfitation products of high emulsion stability providing they are mixed before the oxidizing sulfitation step with fatty acid esters having iodine numbers of from 60 to 100 in a ratio by weight of fat to ester of from 9:1 to 1:4. Suitable fatty acid esters contain from 12 to 24 carbon atoms in the fatty acid residue, which is of natural and/or synthetic origin and which may be linear or branched, and from 1 to 5 carbon atoms in the monofunctional alcohol residue. Fatty acid esters containing unsaturated fatty acid residues can be used either individually or in combination with fatty acid esters containing saturated fatty acid residues. Friese et al. teach that the sulfited fats prepared by oxidation of fats with oxygen-containing gas mixtures and simultaneous or subsequent sulfitation using alkali and/or ammonium hydrogen sulfites. See abstract and col.1,ln.57-col.2,ln.50. Friese et al. teach that the sulfitation products show distinctly better light stability. See col.4, ln.45-55 where Friese et al. illustrate the light fastness of leathers, as measured in accordance with DIN 54 004, oiled with fish oil sulfite reaches stage 1 while leathers treated with the sulfited fats

reach stage 4 or stage 5. Wherein stage 1 signifies very poor light stability and stage 8 very high light stability. See col.4,ln.45-55. In examples 1-8 Friese et al. illustrate oxidative treatment of the fatty acid lubricant prior to further chemical reaction. See col.4-5. In application examples A-D, Friese et al. illustrate oiling of upper leathers in a single bath, comprising neutralizing with sodium formate, retanning and lubricating with a lubricating agent that has been subjected to oxidative treatment. Accordingly the teachings of Friese et al. anticipate the material limitations of the instant claims.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 571-272-1320. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GREGORY DELCOTTO
PRIMARY EXAMINER



Examiner Preeti Kumar
Art Unit 1751